

## **REMARKS/ARGUMENTS**

Claims 1-7 and 21-34 are pending in the present application. Claims 1-6 are amended. Claims 21-34 are added. Support for the amendments to the claims and the new claims is located at least in the previous drafts of the claims and in the Specification on page 3, lines 3-20; on page 9, line 27, through page 11, line 9; on page 11, line 28, through page 12, line 20; on page 13, line 15, through page 14, line 8; on page 17, lines 12-29; on page 20, lines 11-25; and in Figures 2-3. Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 101**

The Examiner has rejected claims 1-7 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

The Examiner states:

Claim 1: Claim 1 is directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. 5 101, it must either: (1) be tied to a particular machine, or (2) transform a particular article to a different state or thing. *See In Re Bilski*, 88 U.S.P.Q.2d 1385 (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively recite the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform underlying subject matter. Although the claim preamble recites that the method is "in a data processing system," this is merely an incidental physical limitation that is insufficient to tie the claimed process to a particular machine.

Claims 2-7: Dependent claims 2-7 are rejected for failing to remedy the deficiencies of the claims from which they depend.

Office Action dated February 13, 2009, pp. 3-4.

Claim 1 is amended to overcome this rejection. Therefore, Applicants respectfully request withdrawal of the rejections of claims 1-7 under 35 U.S.C. § 101.

## **II. Objection to Claims**

The Examiner has stated that claims 1-7 were objected to due to the following informalities:

Claim 1: On line 16, claim 1 recites "responsive to determining that the intended used is conducting a self-assessment." In this limitation, "used" should be replaced with "use."

On lines 6-7, claim 1 recites "wherein assessment data is stored separately from assessment business logic." It is unclear whether the "assessment data" refers to "assessment business logic" or "self-assessment" data. For examination purposes, Examiner will construe "assessment data" as "self-assessment" data.

Claims 2 and 5: Claims 2 and 5 each recite "the data" (claim 2 recites it once and claim 5 recites it twice). It is not clear what data "the data" refers to. For examination purposes, Examiner will construe "the data" as "self-assessment" data.

Claims 2-7: Dependent claims 2-7 are rejected for failing to remedy the deficiencies of the claims from which they depend.

Office Action dated February 13, 2009, page 3.

In response, claims 1, 2, and 5 have been amended to provide clarification and to correct the typographical error as requested by the Examiner. Therefore, the objection to claims 1-7 has been overcome.

## **III. 35 U.S.C. § 103, Obviousness**

The Examiner has rejected claims 1-7 under 35 U.S.C. § 103 as being unpatentable over Griffor, U.S. Patent Application Publication No. 2002/0173999 (hereinafter "*Griffor*") in view of MacDonald, U.S. Patent Application Publication No. 2004/0068429 (hereinafter "*MacDonald*"), and further in view of Nandigama, U.S. Patent Application Publication No. 2004/0010441 (hereinafter "*Nandigama*"). This rejection is respectfully traversed.

The Examiner states:

Claim 1: Griffor discloses a method in a data processing system for providing a consulting assessment environment, the method comprising:

determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic (see ¶ 15, disclosing recording and structuring information produced by the definition phase of the organizational consulting process; ¶ 18, disclosing decomposing an organization; ¶ 19, disclosing a definitional stage and an organizational framework; ¶ 20, disclosing "business rules logic"; ¶ 21, disclosing specification tables constructed during the definitional phase of the consulting process; ¶ 23 et seq., disclosing specification tables; ¶ 51, disclosing an organizational definition) and conducting a self-assessment (see ¶ 16, disclosing an assessment of an organization to align the organization with its purpose; ¶ 19, disclosing determining success based on actual performance; ¶ 21, disclosing storing performance data; ¶ 22, disclosing allowing participants to give feedback on their individual performance), wherein defining assessment business logic is performed by a consultant (see above-cited sections; figure 2), wherein conducting a self-assessment is performed by the consultant or a client (see above-cited sections; figure 2), and wherein assessment data is stored separately from assessment business logic (see figure 3: item 64, disclosing an organizational performance database, and items 62-63, disclosing action rules and specification tables databases that store business logic; ¶ 6, disclosing separate databases for logic and performance; ¶¶ 20-21);

responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to provide the assessment business logic for multiple types of assessments for assessing businesses (see sections cited below);

responsive to determining that the intended use is conducting a self-assessment, receiving data about a business through a questionnaire (see ¶¶ 17-18, disclosing determining the organization's goals, etc.; ¶ 23 et seq., disclosing gathering information generated during the definition phase; ¶¶ 28-31; ¶ 77; figure 2: items 1-4);

responsive to receiving data about the business, computing at least one assessment score based on formulas and rules encoded in the assessment framework template (see ¶ 19, disclosing quantitatively measuring the importance of deliverables; figure 5, depicting relative value and total value; various figures disclosing point values; ¶¶ 41-50; ¶ 79; ¶ 82)

responsive to computing the at least one assessment score, determining an appropriate action based on the at least one assessment score and the suggested actions template encoded with business-related domain knowledge that defines actions to achieve desired states of business (see ¶¶ 19 and 21, disclosing actions rules used to maintain alignment between performance and goals; ¶ 22, disclosing action rule module that provides actions to be taken to help achieve organizational goals; ¶ 50, disclosing constructing action rules based on weights; ¶¶ 65-66; ¶ 82)

reporting results of the assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including

at least one of best practices, business consultant expertise, and business goals (see ¶¶ 54-58, disclosing a management module which provides reports to management; ¶¶ 59-64, disclosing a participant module which provides reports to workers; ¶¶ 72-80).

It is not explicitly clear whether Griffor discloses the claimed "templates" for storing data. MacDonald discloses a similar consulting system for strategic performance management that uses templates in the form of Microsoft Excel spreadsheets (see ¶ 36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to record the information of Griffor in the templates of MacDonald. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by storing information in reusable templates.

Further, Griffor does not explicitly disclose wherein the questionnaire is defined by the data template encoded with business-related domain knowledge of business practices. Nandigama discloses this limitation (see figure 5). Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to store questions in a template. It would have been obvious to one of ordinary skill in the art at the time the invention was made to define the questions asked by Griffor according to a template (such as that in Nandigama or those known in the art). One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by storing information in reusable templates.

Griffor does not explicitly disclose wherein proprietary information and trade secrets are encoded into the data template, the assessment framework template, the suggested actions template, and the report template. However, these limitations are not sufficient to distinguish the claimed invention over the prior art because Griffor manipulates data in the same way as the claimed invention. In other words, the recited method steps would be performed in the same manner regardless of whether or not proprietary information and trade secrets are encoded into the templates. Thus, the prior art and the claimed invention have identical structure and the claimed descriptive material is insufficient to distinguish the claimed invention over the prior art. see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 15 79, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

Griffor does not explicitly disclose wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature. Examiner takes Official Notice that it was well-known in the art at the time the invention was made to limit access to confidential data. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to hide confidential data from clients when performing the method of Griffor. One of ordinary skill in the art would have been motivated to do so for the benefit of increased security. Furthermore, Examiner notes that Applicant has failed to traverse Examiner's Official Notice, which was originally set forth in the previous Office action. Therefore, the above findings of Official Notice are taken to be admitted prior art. See MPEP 5 2144.03 (C).

Examiner also notes that MacDonald and Nandigama also disclose many of the above limitations that Griffor has been shown to disclose.

Office Action dated February 13, 2009, pp. 5-9.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).”

As amended, *Griffor*, *MacDonald*, and *Nandigama*, taken alone or in combination, do not teach or suggest “responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments for assessing businesses, further comprising: encoding the data template, the assessment framework template, the suggested actions template, and the report template with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations; translating a plurality of hypotheses into interview questions for assessing a current state of a business; and encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template, wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding

feature,” as recited in independent claim 1. Therefore, a *prima facie* case of obviousness based on the prior art has not been established when rejecting amended independent claim 1.

*Griffor* is directed to a performance management system. *Griffor*'s method defines organizational goals and prioritizes/ranks the goals in order of importance. Weighted averages are used to calculate a number for prioritizing the goals. The Office Action refers to the following portion of *Griffor* in the rejection of claim 1:

[0017] The consulting process of FIG. 1 involves a determination of the organization's goals, followed by a breakdown of those goals into successively more detailed levels of implementation until they are completely decomposed into a set of deliverables and individual roles for participants within the organization. The deliverables represent specific organizational accomplishments that are required to achieve the organizational goals. The individual roles represent the different responsibilities that each participant has in working toward the accomplishment of one or more of the organizational goals. These individual roles permit all participants to identify the deliverables for which they are responsible along with the skills and time commitment required of them to achieve the deliverable. Using the computer-based technology of the present invention, the voluminous amounts of information that are often generated by the consulting process can, in essence, be filtered to remove the irrelevant information and synthesize out only that which is needed at any time to maintain alignment of the organization's performance with its goals.

*Griffor*, paragraph [0017].

*Griffor* teaches a method for determining an organization's goals. The model consists of actions that reflect the organizational goals. The goals are decomposed into a set of deliverables and individual roles of participants in working toward the accomplishment of the goals. The invention of *Griffor* is directed to maintaining the alignment of the organizations performance with its defined goals. In contrast, in the claims of the present invention, a data template, an assessment framework template, a suggested actions template, and a report template are defined to create the assessment business logic for multiple types of assessments for assessing businesses. The data template, the assessment framework template, the suggested actions template, and the report template are encoded with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations. A plurality of hypotheses is translated into interview questions for assessing a current state of a business. *Griffor* does not teach or suggest these features. These features assist consultants in their

consulting activities rather than providing a specific method for calculating how an organization should prioritize organizational goals and targets/metrics.

In addition, *Griffor* does not teach or suggest that proprietary information and trade secrets are encoded into the data template, the assessment framework template, the suggested actions template, and the report template and are assessable to consultants and made inaccessible to clients using a hiding feature. Applicants respectfully disagree with the Examiner's assertion that it is obvious to add this feature to *Griffor* to increase security by hiding confidential data. *Griffor* does not mention proprietary information, trade secrets, confidential information, a hiding feature, or a motivation for hiding confidential information. In addition, Applicants respectfully disagree that *Griffor* manipulates data in the same way as the claimed invention. Further, Applicants request further clarification with regard to this statement from the Examiner.

The Office Action additionally refers to the following portion of *Griffor* in the rejection of claim 1:

[0019] As shown in FIG. 2, information arising out of this consulting process is captured at each definitional stage (i.e., at each level of elemental components) by a computer-based system that records, manages, and processes the information in a manner which enables the system to assist the performance management of the organization in a number of different ways, including: 1) quantitatively measuring of the importance of the resulting deliverables and individual roles on the ultimate goals of the organization; 2) providing action rules that can be used by participants to maintain alignment of their individual roles with the organizational goals, and 3) providing a framework for the automated determination of organizational success based on actual performance as defined by the deliverables and/or other elemental components using a buyer/seller transactional model. These features will be discussed in greater detail below in connection with the consulting process of FIG. 1. However, it will be appreciated as the description proceeds that the invention can be used with various other consulting techniques that involve a determination of specified requirements needed to achieve higher level goals and that the invention is thus not limited to the specific consulting process disclosed.

*Griffor*, paragraph [0019].

Claim 1 is a method for providing a consulting assessment environment. *Griffor's* invention does not provide a consulting assessment environment. To the contrary, *Griffor* captures information arising out of a consulting process. The consulting assessment environment of claim 1 is provided to automate and improve the activities of a consultant in conducting an assessment. *Griffor's* invention captures the results from a consulting process to quantitatively

measure the importance of the resulting deliverables and individual roles on the determined goals of the organization. In contrast, the data template, the assessment framework template, the suggested actions template, and the report template are encoded with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations. In addition, *MacDonald* and *Nandigama* do not provide for the deficiencies of *Griffor* with respect to independent claim 1.

*MacDonald* is directed to a system and method for developing a strategic organization plan and for presenting the information associated with the plan. *MacDonald* is cited for using templates in the form of Microsoft Excel spreadsheets. *MacDonald* does not teach or suggest “responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments for assessing businesses, further comprising: encoding the data template, the assessment framework template, the suggested actions template, and the report template with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations; translating a plurality of hypotheses into interview questions for assessing a current state of a business; and encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template, wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature,” as recited in independent claim 1.

*Nandigama* is directed to a method and system for mapping metrics to goals of an organization in order to track process improvement. *Nandigama* is cited for allegedly disclosing that the questionnaire is defined by the data template encoded with business-related domain knowledge of business practices. As amended, claims 1 recites that the questionnaire is defined using the data template encoded with the interview questions and business-related domain knowledge of business practices. The interview questions are formed by translating a plurality of hypotheses into interview questions for assessing a current state of a business. *Nandigama* does not teach or suggest these features.

The Office Action refers to Figure 5 of *Nandigama* in the rejection of defining questionnaire:



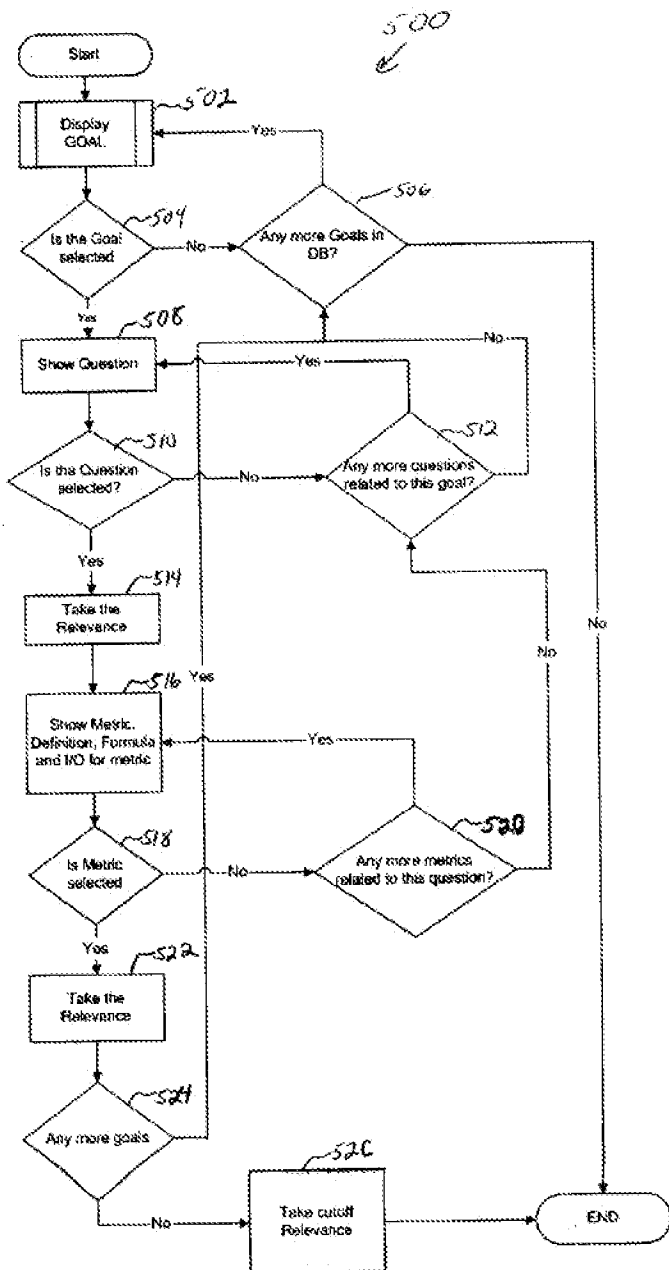


Fig 5

Nandigama, Figure 5.

Figure 5 of *Nandigama* is a flowchart diagram of its method for mapping goals, questions, and metrics. *Nandigama* teaches mapping questions from a questions database to related goals for each of goals of the organization. *Nandigama* does not teach or suggest translating a plurality of hypotheses into interview questions for assessing a current state of a business.

*Griffor, MacDonald, and Nandigama* fail to teach or suggest “responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to create the assessment business logic for multiple types of assessments for assessing businesses, further comprising: encoding the data template, the assessment framework template, the suggested actions template, and the report template with formulas and logic rule definitions to define how self-assessment data is used to generate assessment results and recommendations; translating a plurality of hypotheses into interview questions for assessing a current state of a business; and encoding proprietary information and trade secrets into the data template, the assessment framework template, the suggested actions template, and the report template, wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature,” as recited in amended independent claim 1. Therefore, the alleged combination of *Griffor, MacDonald, and Nandigama* does not teach or suggest these features.

In view of the above, the Examiner has not established a *prima facie* case of obviousness based on the prior art when rejecting independent claim 1. Thus, Applicants respectfully request withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a). In addition, *Griffor, MacDonald, and Nandigama*, taken alone or in combination, do not teach or suggest the features of dependent claims 2-7 at least by virtue of their dependency on claim 1. Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-7 under 35 U.S.C. § 103(a).

In addition to being dependent on its respective independent claim 1, claims 2 and 3 also distinguish over the cited references based on the specific features recited therein. *Griffor, MacDonald, and Nandigama*, taken alone or in combination, do not teach or suggest “identifying a desired state for the business using the assessment framework template and the suggested actions template to analyze the self-assessment data and to determine new business insights and recommendations for the business,” as recited in amended claim 2. In other words, the desired state is identified based on analysis of the self-assessment data and determined recommendations for the business. Then, the appropriate actions to achieve the desired state are determined by performing a gap analysis between the current and desired states. The current state and the identified desired state become the basis for determining the appropriate actions and

a roadmap for the consultant's recommendations for moving forward. In contrast, *Griffor's* invention conforms to the defined goals of the organization.

Additionally, *Griffor*, *MacDonald*, and *Nandigama*, taken alone or in combination, do not teach or suggest "identifying benefits and risks for the current state of the business and for moving to a desired state of the business based on the at least one assessment score and the appropriate action," as recited in amended claim 3. *Griffor* and *Nandigama* are focused on calculating goals and *MacDonald* is focused on scorecard optimization.

#### **IV. New Claims 21-34**

Claims 21-34 are computer program product and apparatus claims that contain the same subject matter of the method claims 1-7. Therefore, *Griffor*, *MacDonald*, and *Nandigama*, taken alone or in combination, do not teach or suggest the features of claims 21-34 for the same reasons discussed above.

#### **V. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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GHG/VJA

Respectfully submitted,

/Gerald H. Glanzman/

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